

REMARKS

Claims 2-14 and 22-26 are currently pending in the application. Claims 2-14 and 22-26 are presently before the Examiner.

Claim Rejections under 35 U.S.C. § 103

Claims 2-14 and 22-26 were rejected as allegedly being obvious over U.S. Patent No. 5,991,751 (“Rivette”) alone, or in combination with U.S. Patent No. 6,556,992 (“Barney”) and/or Houben. Applicants respectfully traverse the rejections.

The particular context of the pending claims, that being legal services and attorney work product, are especially important and are entitled to patentable weight. If these features were not critical, then the West km product, which is encompassed by the pending claims, would not have enjoyed any commercial success or solved a long-felt but unsolved need as set forth in the prior response.

Claim 22 recites in pertinent part:

- b) means, responsive to the received query, for searching at least first and second physical or logical databases for content related to the query, with the first database including:
 - (i) a set of work-product documents of the law firm generated by retrieving documents selected from a third database containing work product documents, wherein the retrieved work product documents are converted into a markup language and subsequently *indexed based on citations* and text to permit the work product documents to be searched by the searching means...

The Office Action does not dispute that Rivette and Barney fail to teach indexing documents based on citations and text. Instead, at page 12, the Office Action alleges that this critical gap is filled by Paragraph 52 of Houben. As best understood, this is an allegation that “citations” are an “intended use” of an XML markup language.

Houben does not reference citations or legal documents. A “citation” is affirmatively recited by Claim 22 and is entitled to patentable weight. Citation in the presently claimed context of legal documents is generally understood to a citation to authority, such as caselaw. A dictionary definition (from www.freidictionary.com) appears below:

ci·ta·tion  (sī-tā' shən)

n.

1. The act of citing.
- 2.
- a. A quoting of an authoritative source for substantiation.
b. A source so cited; a quotation.
3. ***Law A reference to previous court decisions or authoritative writings.***
4. Enumeration or mention, as of facts, especially:
a. An official commendation for meritorious action, especially in military service: a *citation for bravery*.
b. A formal statement of the accomplishments of one being honored with an academic degree.
5. An official summons, especially one calling for appearance in court.

(Emphasis added). The Office Action has failed to give any patentable weight to “citation” and the references of record such as Rivette, which are directed to patent search engines, do not remedy the deficiencies of Houben. As such, the references of record, taken alone or in combination, do not teach or suggest each and every element of Claim 22. For this reason, a proper *prima facie* case of obviousness has not been set forth. The dependent claims add further distinguishing features to the invention claimed, and further distinguish the art of record. Applicant therefore respectfully requests for the rejection to be withdrawn and for the claims to be allowed.

Applicant submits that this Amendment After Final and the accompanying Remarks do not raise new issues for consideration or necessitate the undertaking of any additional search of the art by the Examiner, and thus may properly be entered into the record. As such, this Amendment After Final should therefore allow for immediate entry by the Examiner in preparation for Appeal by Applicant.

Applicant also submits that entry of this Amendment After Final and the accompanying remarks would place the present application in better form for appeal, should the Examiner dispute the patentability of any of the pending claims.

CONCLUSION

Applicants respectfully request allowance of this application. The Director is hereby authorized to charge any fee deficiency associated with this paper (or with any paper filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 85192(307534).

Respectfully submitted,

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